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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/781,088

02/17/2004

Robert J. Simmons

J-BSIM.1011

3395

56703

7590

12/17/2008

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EXAMINER

WENDELL, MARK R

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

12/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/781,088 | <b>Applicant(s)</b><br>SIMMONS, ROBERT J. |  |
|                              | <b>Examiner</b><br>MARK R. WENDELL   | <b>Art Unit</b><br>3635                   |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6625937) in view of Davis (US 6347487). Regarding claims 1 and 6, Parker illustrates in Figure 6 a plural-story building structure (Figure 6 of Parker) comprising a pair of vertically spaced stories including a lower story and a higher story (See Figure below), with each possessing a normal full plate-height internal volume, and with the lower story additionally being characterized by an internal volume which is defined, at least in part, by an unimpeded full plate-height, wherein a full plate-height story is defined as having a height extending from a building-story floor elevation (top of 42) to the building-story ceiling elevation (bottom of 61) for any story of the building, and wherein said building-story floor elevations and said build-story ceiling elevation are those elevations coincident with beams (42 and 61) in the plural-story building structure, and a utilities-conduit containment space (See Figure below) in the form of a sub-story disposed independently and directly vertically intermediate said lower and higher

stories, possessing a less than normal full plate-height internal volume, having height which lies wholly above the lower story and wholly below the higher story.

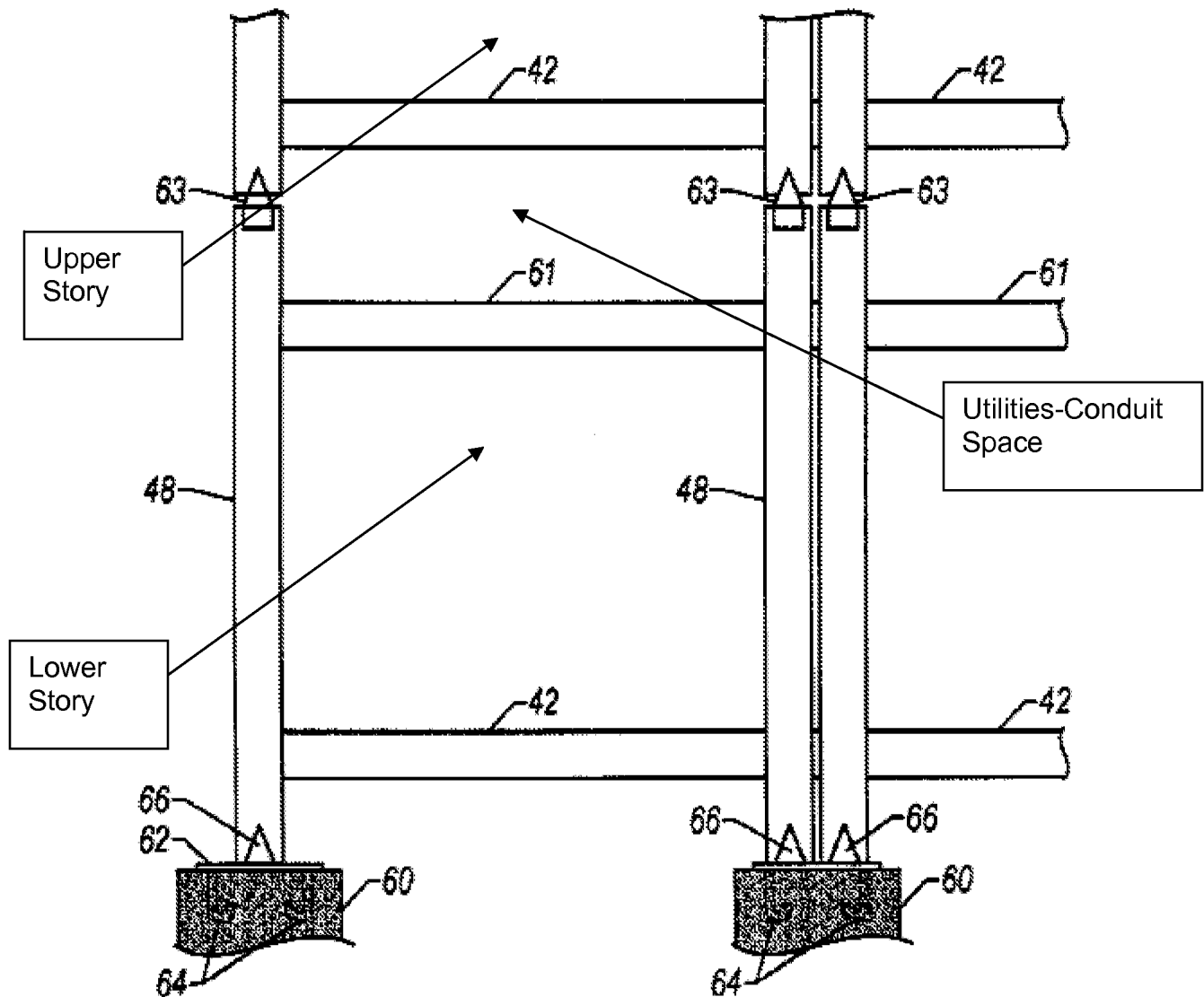


FIG. 6

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However, Parker does not distinctly disclose the space between the floors housing utilities. It is well known in the art of building construction to house utilities within spaces between floors (such as within the beams separating the floors, drop ceilings, and raised floors). Davis illustrates in Figures 6 and 14 a sub-story (10) being constructed and arranged to contain utilities-conduit structure (95-98) relevant to the supply of utilities services upwardly (see column 9) from said containment space toward said higher story, with related utilities services supply to said utilities-conduit structure extending thereto in a manner avoiding any presence within the mentioned internal volume of said lower story, wherein the height of the sub-story does not diminish the full plate-height internal volume. It would have been obvious to one having ordinary skill in the art at the time of invention to utilize the space small space between the upper and lower stories of Parker as a housing for utilities as in Davis in order to save space and enhance the safety and aesthetics of the structure by limiting the amount of wiring and piping within the living space.

The examiner further notes that Parker discloses in column 8 that “it will be apparent to those of skill in the art that variations may be applied to the structures...without departing from the concept, spirit and scope of the invention.” The scope of the invention as laid out by the inventors in columns 1 and 2 is to provide a multi-story living space.

Regarding claim 3, Davis illustrates in Figure 6 and Parker illustrates in Figure 6 the lower stories being ground-level stories.

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Regarding claim 4, Davis illustrates supply-input portions (95) within the utilities-conduit space. The examiner also notes that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). The supply input is connected to existing utility connections (see line 44 of column 9) including sewage holding tanks, generators and a pump, all of which would have to be not only external to the utility conduit space, but generally located on the outside of the building.

Regarding claims 5 and 7 Davis illustrates the containment space (10) including a water-impervious lining (18) to prevent any liquid drainage or intrusion from taking place (column 9, lines 55-67).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-7 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/M. R. W./  
Examiner, Art Unit 3635  
December 9, 2008